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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,853	09/04/2003	David Charles Lyons	12929.1122US02	8586

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FAEGRE & BENSON, LLP  
PATENT DOCKETING  
90 SOUTH SEVENTH STREET  
2200 WELLS FARGO CENTER  
MINNEAPOLIS, MN 55402

EXAMINER
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COCKS, JOSIAH C

ART UNIT	PAPER NUMBER
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3749

DATE MAILED: 12/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/656,853

Applicant(s)

LYONS ET AL.

Examiner

Josiah Cocks

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on RCE filed 9/22/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8, 10-12, 15, 17, 19, 22, 24-29 and 32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-12, 15, 17, 19, 22, 24-29, 32, and 32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                           | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/22/2006 has been entered.

By this amendment, applicant has cancelled claim 33 thus obviating the prior 35 USC 102 rejection on the basis of Schroeter et al.

Claims 1-8, 10-12, 15, 17, 19, 22, 24-29, 31, and 32 are currently pending in the application.

***Drawings***

2. The examiner again notes that the original drawings filed 9/4/2003 and the replacement drawing sheet for drawings sheet 4 showing previously omitted Figs. 5 and 11 submitted 2/5/2004 have been accepted. Although Figs. 5 and 11 were not submitted with the original application, these drawings are not considered by the examiner to show new matter and the subject matter illustrated in Figs. 5 and 11 appears to properly show that which was described in specification as originally filed (see the Brief description of the drawings on page 4 of the specification and the detailed description of the subject matter of Figs. 5 and 11 provided on pages 8-10).

As previously noted, the drawings filed 3/4/2004 are not accepted as these drawings are not labeled "Replacement sheets." It appears that these drawings showing Figs. 5 and 11 are duplicates of the Figs. 5 and 11 submitted 2/5/2004 with the only distinction appearing in how the pages are labeled, i.e. "sheet 1 of 1" (2/5/2004) versus "sheet 4 of 6" (3/4/2004). However, the Figs. 5 and 11 filed 2/5/2004 are indicated to replace the drawing sheet 4, which shows duplicate Figs. 6, 7, and 8 (as also shown in drawing sheet 5). Accordingly, the drawing sheet showing Fig. 5 and 11 submitted 2/5/2004 is properly considered to replace the previously filed drawing sheet 4.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-6, 8, 10-12, 15, 17, 19, 22, 24-27, 29, 31, and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication 2004/0011352 to Bachinski et al. ("Bachinski").

Bachinski discloses in the specification and Figs. 1-3 an invention in the same field of endeavor as applicant's invention and as described in applicant's claims 1-6, 8, 10-12, 15, 17, 19, 22, 24-27, 29, 31, and 32. In particular, Bachinski shows a fireplace (100 or 400) and method

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forming the fireplace that includes providing a molded first member (at least 404) of surround (461) for attachment to the fireplace wherein the surround includes first and second side members (note at least one side edge of the surround is illustrated and corresponding other side member is also considered to be present, see Fig. 3) and includes an opening extending between the sides (see unnumbered opening in top portion of surround 461 in Fig. 3) and placed such that air from vents (460) is directed through the opening.

Bachinski further shows a front facing side (exposed surface 404) and a rear facing side (vertical plane formed at the portion of surround 461 that contacts front panel 403 of the fireplace). Between these sides is a cavity (see space formed between surround fireplace front 403 and below upper horizontal portion of the surround 461) that is considered to be formed in the first/top member between the sides as recited. Unnumbered louver portions adjacent the vents (460) that extend into the cavity are considered to be the shield as recited (see Fig. 3 and numbered lines to the right of the arrow identifying reference number 460). Activation panel (401) is provided in the cavity and is considered to be an insulating member that is placed in the cavity in a position between the shield and the front facing side of the top member and adapted to dissipate heat (note discussion of thermal insulation as applied to similar panel 300, page 2, paragraph [0027]).

In regard to at least claims 2 and 24, the surround (461) is considered to have side members that are oriented along vertical sides of the fireplace as recited.

In regard to at least claims 3 and 26, note horizontal portion of the surround (461) at the top of Fig. 3.

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In regard to at least claims 4 and 25, note unnumbered lower portion of surround (461) shown just above the unnumbered lower opening in Fig. 3 but below a top portion of the surround (461).

In regard to at least claim 5, the surround member including its side and top portions are shown described as being molded of a single piece of material (see Fig. 3 and col. 3, paragraphs [0036] and [0038]).

In regard to at least claims 11, 19, 31, and 32, the surround is molded from compression or vacuum molded materials and contains a ceramic fiber and binder (see page 3, paragraphs [0036] and [0038]).

In regard to at least claims 6 and 27, the unnumbered portion at the bottom of the surround (461) below the unnumbered opening shown in Fig. 3 is considered to be the access panel as recited.

In regard to at least claim 8, when the surround (461) is attached to the fireplace as shown in Fig. 3 the examiner considers that the unnumbered opening in the top member would extend along the entire length of the vents (160) (e.g. see Fig. 1). The recitation of "distinct" openings is considered to only require some demarcation between the openings. Broadly construed, the examiner considers that the opening extending along the vent (160) may be considered to have at least a left most portion and a rightmost portion, which are regarded as distinct openings of the surround.

In regard to at least claim 10, the surround is described as being "attached" to the front panel (403, col. 3, paragraph [0036]) and is thus considered to be secured by some connector as recited.

In regard to at least claim 15, the top member of the surround (461) is positioned vertically above the combustion chamber in the same manner as disclosed and claimed by applicant.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-5, 8-10, 12, 15, 17, 20, 22, 24-26, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,409,870 to Duffney ("Duffney") in view of U.S. Patent No. 5,307,801 to Schroeter et al. ("Schroeter").

Duffney discloses in the specification and Figs. 1-29 a decorative surround for a fireplace (see col. 2, line 7) in the same field of endeavor as applicant's invention and similar to that described in applicant's claims 1-5, 8-10, 12, 15, 17, 20, 22 24-26, and 29. In particular,

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Duffney shows a one-piece molded surround (see Fig. 1) that includes a top member and first and second side members that define a cavity (see Figs. 3 and 4 and note groove/cavity 24).

Duffney further describes that that openings (such as 20) may be milled, routed or lazered as desired into the surround (see col. 4, lines 42-57).

In regard to at least claims 1 and 12, the top member includes a front facing side and a rear facing side (front 12 and rear 22) in a spaced apart relationship. The top member is further considered to define a cavity between the front and rear sides.

In regard to the recitation of a shield, the interior surface walls (26) of openings (20) (see at least Fig. 3) would function to direct heat through the openings and are considered to be the shield configured to/positioned within the cavity.

In regard to the recitation of the insulating member, Duffney discloses that a filler (30) made of insulating materials (see col. 5, lines 24-36) may be provided in the cavity (see Fig. 3).

In regard to at least claims 2 and 3, side members of the surround (e.g. 18) extend in a vertical direction and the top member extends in a substantially horizontal direction (note the thickness of surround at top portion is considered to be horizontally extending).

In regard to at least claim 4, note unnumbered lower member (see lower portion of Fig. 1).

In regard to at least claim 5, note the surround is shown and described as a single/monolithic piece (see Fig. 1 and col. 5, lines 21-28).

In regard to at least claim 8, top member of the casing/surround (10) shows multiple distinct openings (see Figs. 1-9).

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In regard to the recitation that the cavity is in fluid communication with a vent of a fireplace and that the opening is configured to exhaust the collected air, while Duffney discloses use of his decorative casing as a fireplace surround, no fireplace with a vent or heating source is disclosed or associated connector to secure the surround to the fireplace

However, Schroeter is cited to show to the general arrangement of a fireplace (10) with vents and a heating source (38). In Schroeter, the fireplace (10) includes a surround (at least casing panels, 20, 22, 24, 26, 28, see col. 3, lines 43-49 and Fig. 1) arranged adjacent a vent of a fireplace (air exhausted from plenum 62) and shown secured via some connecting means/connector the fireplace (see Figs. 1 and 2). The surround includes an opening (74) arranged at the vent to exhaust collected air.

In regard to at least claim 15, the top of the surround/casing (10) of Duffney would be positioned vertically above the combustion chamber when attached to a fireplace as taught in Schroeter.

Therefore, the examiner considers that it would be obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the decorative surround of Duffney with the fireplace of Schroeter to desirably provide an artistic accent feature for the front of a fireplace (see Duffney, col. 1, lines 35-40 and col. 2, lines 5-9). In doing so, the surround of Duffney would be arranged such that the cavity (24) would be in communication with the vent of Schroeter. Further, in order to provide the exhaust feature of opening (74) in Schroeter a person of ordinary skill in the art would reasonably recognize that similar openings would be provided in Duffney as locations adjacent the vents by the milling, routing or lazering procedure disclosed

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in Duffney (see col. 4, lines 42-57) in order for the vents to perform their specified venting function.

8. Claims 6, 7, 27, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duffney in view of Schroeter as applied to claims 5 and 27 above, and further in view of U.S. Patent No. 6,026,805 to Burch et al. ("Burch").

Duffney in view of Schroeter disclose all the limitations of claims 6, 7, 27, and 28 except for a removably secured access panel.

Burch discloses a fireplace in the same field of endeavor as applicant's invention and Duffney. In Burch, a fireplace includes a front panel/surround with a lower opening (60). Access to burner controls (36) are provided through this opening (see Fig. 4). Burch explicitly provides that a removable access panel (39) is provide over this opening to cover the opening the burner controls (see col. 4, lines 5-7). The examiner notes that this arrangement of a lower opening and lower burner controls is substantially identical to that shown in Schroeter (note at least Fig. 7 and control 40). While Schroeter does not appear to discuss a covering for the opening (62, see Fig. 1) which provides access to control (40) the examiner considers that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate a removable access panel as taught in Burch over the opening of Schroeter for the purpose of covering the opening after manipulation of the burner controls.

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9. Claims 11, 16, 19, 31, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duffney in view of Schroeter as applied to claims 1 and 22 above, and further in view of U.S. Patent No. 3758,317 to Moore ("Moore").

Duffney and Schroeter disclose all the limitations of claims 11, 16, 19, 31, and 32 except that the molded material is a ceramic material with a binder and formed through compression molding. Duffney does however note that the material of the surround may be a variety of materials of any other material preferred (see col. 4, lines 20-23).

Moore teaches an article and method of making the article that is considered analogous to the problem of molding a surround for a fireplace. In Moore, an article that is useful for forming a monolithic structure for use as a facing, other decorative purposes, or for household burners (see col. 8, lines 68-72) is made of a ceramic material that includes a binder (see col. E, lines 10-31). Further, this article is made through vacuum or compression molding (see col. 8, lines 45-48).

Therefore, in regard to claims 11, 16, 19, 31, and 32, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the molded surround of Duffney to be made of the material and in the manner disclosed in Moore to desirably provide a monolithic structure having a desired physical property suitable to function as a facing or burner portion (see Moore, col. 1, lines 187-25 and col. 8, line 68-72).

#### ***Response to Arguments***

10. Applicant's arguments filed 8/10/2006 and entered with the RCE submission of 9/22/2006 have been fully considered but they are not persuasive.

Applicant argues that Bachinski does not disclose the elements of independent claims 1, 12, 17, and 22. In particular, applicant argues that Bachinski does not show the surround have a front facing side and a rear facing side in a spaced apart relationship that defines a cavity such that the shield member is configured to fit within the cavity and the insulating member is placed within the cavity. The examiner does not agree.

In Bachinski, the front side of the surround (461) is shown at exposed surface (404) and the rear side is shown at the plane of the portion of the surround that contacts front panel (403) of the fireplace (see Fig. 3). The cavity is the space between the front panel and the back portion of the exposed surface (404). The shield member is considered the louvers extending from vent (160) which extend into the cavity. The insulating is formed by the thermal insulating portions applied to activation panel (401) (note discussion of thermal insulation as applied to similar panel 300, page 2, paragraph [0027]).

Applicant further contends that the surround of Bachinski is “formed of a flat piece with a hole in it” (response, p. 8). However, the examiner notes that the surround (461) of Bachinski clearly includes a horizontal component (top of surround in Fig. 3) that is distinct from the flat front exposed panel (404). The surround is therefore not a flat sheet as asserted by applicant. As has been noted, the rear side of the surround (461) is considered to be defined at least in part by this top portion that extends horizontally away from the front exposed surface (404).

Applicant also argues that the claims are patentable over the Duffney and Schroeter combination. In particular, applicant argues that the filler (30) of Duffney is not placed within the cutouts formed in the surround, thus not placed in the cavity, and is not adapted to dissipate heat. The examiner does not agree.

The cavity in Duffney is formed by opening formed by cutouts (20) as well as the longitudinal groove (24). The filler (30) is placed at least within the longitudinal groove and is thus placed in the cavity as recited (see at least Fig. 3). Further, the filler is made of material understood to have insulating properties (e.g. plywood, presswood, filler board, see col. 5, lines 24-26) and this therefore properly regarded as be "adapted to dissipate heat."

Applicant also appears to argue that if the surround of Duffney were combined with the fireplace of Schroeter the front face of surround of Duffney would function to "completely stop the air flow out of the vent" of Schroeter (see response, p. 9). In response, the examiner notes the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, the surround of Duffney is clearly considered to be used in conjunction with the fireplace (see Duffney, col. 1, lines 35-40 and col. 2, lines 5-9). The examiner considers a person of ordinary skill in the art would reasonably understand the type of fireplace reference in Duffney to be that shown in Schroeter. Further, in attaching the surround of Duffney to the fireplace of Schroeter a person of ordinary skill in the art would reasonably seek to render the vents of the fireplace of Schroeter operable for their intended purpose of providing vented air to the room. In doing so, as noted above, a person of ordinary skill in the art would reasonably provide appropriate holes in either the filler material or in the surround by the milling, routing or lazering procedure disclosed in Duffney

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(see col. 4, lines 42-57) to enable air flow through the surround. Accordingly, the combined teachings of the references suggest the invention as recited in applicant's claims.

The teachings of Moore and Burch have not been disputed by applicant. Accordingly, these references are considered to properly show that for which they have been cited.

Accordingly, applicant's claims are not considered to patentably distinguish applicant's invention over the prior art of record.

### *Conclusion*

11. This action is made non-final. A THREE (3) MONTH shortened statutory period for reply has been set. Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.

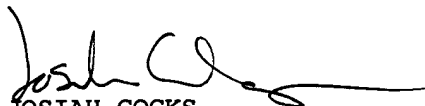
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Josiah Cocks whose telephone number is (571) 272-4874. The examiner can normally be reached on M-F 8:00-5:30.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

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like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

jcc  
December 7, 2006



JOSIAH COCKS  
PRIMARY EXAMINER  
ART UNIT 3749